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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/137,277	08/20/1998	TOSHIAKI SETOGAWA	450100-4535	2700

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FROMMER LAWRENCE & HAUG  
745 FIFTH AVENUE- 10TH FL.  
NEW YORK, NY 10151

EXAMINER

NGUYEN, CAO H

ART UNIT PAPER NUMBER

2173

DATE MAILED: 02/05/2002

18

Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.  
09/137,277

Applicant(s)  
Toshiaki et al.

Examiner  
Cao "Kevin" Nguyen

Art Unit  
2173



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on Sep 5, 2001

2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 1-13 is/are pending in the application

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 1-13 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirements

## Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some\* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other:

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## DETAILED ACTION

### *Request for Continued Examination (RCE)*

1. The request filed on November 11, 2001 for a Request for Continued Examination (RCE) under 37 CFR 1.53(d) based on parent Application No. 09/137,277 is acceptable and a RCE has been established. An action on the CPA follows.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

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3. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bond-Harris et al. (US Patent No. 5,990,972) in view of Yoshio et al. (US Patent No. 6,215,952).

Regarding claim 1, Yoshio discloses a disk recording medium retaining menu control method for controlling displaying menu including at least one menu button for selecting an operation of disk recording, the display menu being determined at least in part on the basis of previously selected operations (see col. 1, lines 9-18), displaying a predetermined response picture when the operation of menu button on menu is selected. (see col. 12, lines 11-44). However, Yoshio fails to explicitly teach response display data which provides instructions for displaying the response picture data thereby indicating a transition between menu and the selected operation and operation instructions for performing the selected operation after response picture is displayed.

Bond-Harris teaches response display data which provides instructions for displaying the response picture data thereby indicating a transition between menu and the selected operation (see col. 4, lines 14-67 and col. 5, lines 10-47). It would have been obvious to one of an ordinary skill in the art at the time the invention was to provide instructions for displaying the response picture data thereby indicating a transition between menu and the selected operation as taught by Bond-Harris to the video information record medium of Yoshio, in order selecting menus, editing, developing, and executing a multimedia presentation on a display screen. It would enable user to manipulate menu button for interacting video menu system transition between menu and selected operation

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Regarding claims 2-3, Bond-Harris discloses wherein response picture includes a moving picture and sound (see col. 6, lines 6-42). It would have been well known in the art that using MPEG for displaying video clip.

Regarding claims 4-5, Bond-Harris discloses assigned to menu button and operation instruction execute the specified operation (see col. 6, lines 25-65).

Regarding claims 6-7, Bond-Harris discloses wherein response picture includes a moving picture with sound and data is recorded as a series of data (see col. 7, lines 5-17).

As claims 8-13 are analyzed as previously discussed with respect to claims 1-7 above.

***Response to Arguments***

4. Applicant's arguments filed on September 05, 2001 have been fully considered but they are not persuasive.

On pages 5 of the Remark, Applicant argues that the combination of Yoshio and Bond-Harris fails to teach or suggest "a display menu or equivalent at controlling a display and the PCI or the display is determined at least in part on the basis of previously selected operations". However, the limitations as claimed set forth to read on "By the high light information, for example, the change of the picture plane display as well as the display position to be changed with respect to the selection item selected on a special picture plane of selection items (i.e. a so-called menu picture plane) for the audience to select, and the command corresponding to the selected

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item (i.e. a command to be performed in correspondence with the selected item) are set; which is conditioned display based on selection". (see Yoshio col. 12, lines 13-34).

On pages 5 of the Remark, Applicant argues that the combination of Yoshio and Bond-Harris fails to teach or suggest "providing instruction with response display data for displaying the response picture data". However, the limitations as claimed broadly to read on Bond-Harris "instruction for displaying the foreground text data to overlay the background video images, and responding to a command from the user based on the video menu, wherein the foreground text data and the instruction form a script; a processing engine coupled to the program encoder and to the script station which processes the compressed background video images to generate a clip, and assembles the script into a number of script packets which are associated with the clip; a server coupled to the processing engine which stores the clip, and continuously broadcasts the clip simultaneously with the associated script packets into a broadband transmission medium; and an end-user device coupled to the broadband transmission medium to receive the clip and associated script packets, which using the clip, displays the background video images, and using the script packets, overlays foreground text on the displayed background video images" (see col. 8, lines 40-67).

In response to applicant's argument on page 5 that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the

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knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Yoshio teaches conditioned display based on selection used in combination of Bond-Harris's providing instructions with response to displaying picture data. One skilled in the art would have enabled user to manipulate menu button for interacting video menu system transition between menu and selected operation.

***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (See PTO-892)

***Response***

6. Responses to this action should be mailed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231. If applicant desires to fax a response, (703) 308-6306 may be used for formal communications.

Please label "PROPOSED" or "DRAFT" for informal facsimile communications. For after final responses, please label "AFTER FINAL" or "EXPEDITED PROCEDURE" on the document.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA. Sixth Floor (Receptionist).

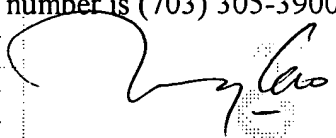
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*Inquires*

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cao (Kevin) Nguyen whose telephone number is (703) 305-3972. The examiner can normally be reached on Monday-Friday from 8:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Cabeca, can be reached on (703) 308-3116. The fax number for this group is (703) 308-6360.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.



Cao "Kevin" Nguyen  
June 02, 2001  
**PRIMARY EXAMINER**  
**Art Unit 2173**